

Response to Office Action mailed June 27, 2008

Serial No. 10/624,925

Applicants: Russell E. Evans et al.

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration of this application in view of the following comments.

Summary of the Office Action and Response

In the Final Office Action dated June 27, 2008, claims 13-32 were examined and rejected as follows:

- Claims 13-17, 20-22, 27 and 29-32 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over U.S. Patent No. 6,638,450 to Richard (the “Richard patent”) in view of U.S. Patent No. 5,110,514 to Soane (the “Soane patent”) and U.S. Patent No. 4,929,707 to Nagata *et al.* (the “Nagata patent”).
- Claims 18 and 23-26 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Richard patent in view of the Soane patent, the Nagata patent, and further in view of U.S. Patent No. 5,746,949 to Shen *et al.* (the “Shen patent”).
- Claims 19, 24 and 28 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Richard patent in view of the Soane patent, the Nagata patent, and further in view of U.S. Patent No. 4,693,446 to Orlosky (the “Orlosky patent”).
- Claims 13-32 were rejected on the grounds of nonstatutory obviousness-type double patenting, as allegedly unpatentable over claims 1-17 of U. S. Patent No. 6,391,231 to Evans *et al.* (the “Evans patent”) in view of the Soane patent and the Nagata patent.

Applicants respectfully traverse these rejections for the reasons set forth below.

I. The Rejections of Claims Under 35 U.S.C. § 103(a)

All of the § 103(a) rejections of claims 13-32 rely at least in part on the Richard patent, “for reasons of record.” In previous office actions, the Examiner had cited the Richard patent for its disclosure of a basic injection molding apparatus with “injection occurring from the side – i.e., a side-fill gasket” [Office Action dated June 1, 2006, page 2], and he further had stated “the method of Richard uses a structure that would include a sidefill gasket with one or more inlet port holes (see 42 in Fig. 5) and that the injection of the material is such that it flows

above and below the polarizer film 12 – see column 5, lines 13-20” [Office Action dated November 7, 2006, page 2].

In response, Applicants previously submitted a Response dated February 25, 2008, including a Declaration of Nancy L. S. Yamasaki Under 37 C.F.R. § 1.131 to establish that the claimed invention was conceived and diligently reduced to practice from a time prior to the November 2, 2000 effective filing date of the Richard patent.

In the June 27, 2008 Office Action, the Examiner stated that he had considered the arguments filed on February 25, 2008, but that they were not persuasive. The Examiner indicated that the Declaration of Nancy Yamasaki was not probative because the Exhibits to the Declaration do not reveal what material was used in the experiments.

In response, Applicants submit a Supplemental Declaration of Russell E. Evans, Thomas A. Balch And Nancy L. S. Yamasaki Under 37 C.F.R. §1.131 to provide further evidence that, although not explicit, the Exhibits describe experiments using optical-quality parts of high-impact polyurethane-based material. Specifically, Paragraphs 4 and 5 of the Supplemental Declaration states that

Exhibits B and C describe two discrete sets of research experiments, both conducted directly by Russell Evans prior to November 2, 2000, using liquid-phase polymeric material to make optical-quality parts of high-impact polyurethane-based material. These experiments with the high-impact polyurethane-based material were conducted both with and without polarizers, in order to further evaluate the methods of manufacturing. The experiments demonstrate the development of manufacturing concepts by the inventors, and preliminary evaluation of embodiments of those concepts.

The heading of “Phoenix” on Exhibit B and the heading in Exhibit C of “Used stop/start to fill assemblies (foot control better)”

indicate that these experiments were conducted with high-impact polyurethane-based material. "Phoenix" identifies the location for the machinery used in Russell Evans' experiments. At the time of Russell Evans' experiments, it was only at this location that we had access to equipment that could process the high-impact polyurethane-based optical material, and at that location, no other types of material were processed by us. Similarly, the description in Exhibit C of a filling method ("Used stop/start") is our description of a particular filling technique that was only associated with the processing of high-impact polyurethane-based optical material into an optical construct. It describes an interrupted method (stop/start) of introducing the liquid-phase polymeric material into the mold cavity.

Accordingly, Applicants believe that the Supplemental Declaration is sufficient to establish that the claimed invention was conceived and diligently reduced to practice from a time prior to the November 2, 2000 effective filing date of the Richard patent. Because all of the § 103 rejections of claims 13-32 are based at least in part on the Richard patent, these rejections are improper and should be withdrawn.

II. The Non-Statutory Double-Patenting Rejection

As mentioned above, claims 13-32 also were rejected on the grounds of nonstatutory obviousness-type double patenting, as being allegedly unpatentable over claims 1-17 of the Evans patent in view of the Soane and Nagata patents.

During a telephone conference with the Examiner on August 29, 2008, the Examiner indicated that the terminal disclaimer had been approved. Therefore, this double patenting rejection is moot and should be withdrawn.

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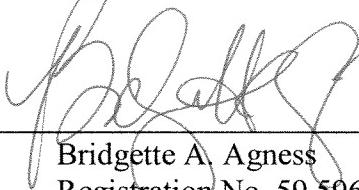
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Conclusion

This application should now be in condition for a favorable action. Issuance of a notice of allowance is respectfully requested. If the Examiner believes that a telephone conference with Applicants' undersigned attorney of record might expedite the prosecution of this application, he is invited to call at the telephone number indicated below.

Respectfully submitted,

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